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(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Martin E. Schwab et al.

Allowed:

Application No.: 09/830,972

Confirmation No.: 7264

Filed: September 24, 2001

Art Unit: 1649

For: NUCLEOTIDE AND PROTEIN
SEQUENCES OF NOGO GENES AND
METHODS BASED THEREON

Examiner: D. E. Kolker

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR REVIEW OF PATENT TERM ADJUSTMENT UNDER
37 C.F.R. §§ 1.181 & 1.705(B)

Dear Sir/Madam:

This is a Petition for Review of Patent Term Adjustment under 37 C.F.R. §§ 1.181 & 1.705(b) to correct the zero days of Patent Term Adjustment indicated for the above-referenced allowed patent application. Applicant respectfully submits that the above national phase patent application which was filed on May 2, 2001, be accorded Patent Term Adjustment under 35 U.S.C. § 154(b). Applicant respectfully requests that the Patent Term Adjustment be corrected to two hundred ninety six (296) days.

STATEMENT OF FACTS

1. Applicant filed the instant application pursuant to 35 U.S.C. § 371 on May 2, 2001, as the U.S. national phase of international patent application no. PCT/US99/26160, filed November 5, 1999.
2. The Office mailed a Notice of Allowance on June 26, 2009, with 0 days of Patent Term Extension under 35 U.S.C. § 154(b).
3. During prosecution, there was no interference proceeding, no imposition of a secrecy order and no review by the Board of Patent Appeals and Interferences or a Federal Court. The patent application is not subject to a terminal disclaimer.
4. The Office mailed a Notice of Missing Requirements under 35 U.S.C. §371 in the United States Designated/Elected Office (DO/EO/US) on June 26, 2001.
5. Applicant filed the missing requirements by September 24, 2001, establishing September 24, 2001, as the 371(c) date.
6. The Office mailed a requirement for restriction on August 28, 2003.
7. Applicant filed a response to the requirement for restriction on December 1, 2003.
8. The Office mailed a nonfinal office action on February 19, 2004.
9. Applicant filed a response to the non-final office action on August 19, 2004.
10. The Office mailed a first Notice of Allowance on October 28, 2004.
11. Applicant paid the Issue Fee on January 26, 2005.
12. Applicant filed a petition to withdraw from issue and a Request for Continued Examination (RCE) on March 18, 2005.
13. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in § 1.704, but for those circumstances set forth in paragraph 25 below.
14. The Office mailed a second Notice of Allowance on June 26, 2009.

**THE PATENT TERM ADJUSTMENT OF 0 DAYS
INDICATED ON THE NOTICE OF ALLOWANCE IS NOT CORRECT**

**A. Applicant submits that Applicant is entitled to Patent Term Adjustment
under 35 U.S.C. § 154(b) and 37 C.F.R. § 1.702**

15. An inspection of the Patent Term Adjustments page on PAIR, a copy of which is attached hereto as Exhibit A, reveals that the Office accorded, as of June 26, 2009, the mailing date of the second Notice of Allowance, zero (0) days of Patent Term Adjustment 35 U.S.C. § 154(b). Applicant contests the calculation of the zero (0) day patent term adjustment.
16. Because the Office did not accord any days of Patent Term Adjustment under either under 35 U.S.C. § 154(b), it appears that the Office used the November 5, 1999, filing date of the international application PCT/US99/26160, from which this is a national stage filing, as the actual filing date of the instant application.
17. 37 CFR § 1.702 provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 for original applications, other than design applications, filed on or after May 29, 2000. The USPTO has indicated that to be eligible for PTA, the international application must have an international filing date of May 29, 2000 or later. See section 4405(a) of the AIPA, 35 USC § 363, and 37 CFR § 1.702(f).
18. 35 USC § 363 states that an international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title. (Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392.)

19. In contrast, the wording of 35 U.S.C. § 154(b)(1)(B) below indicates that Congress used the phrase "actual filing date" for the purpose of patent term adjustment to be the date the national stage application commenced under 35 U.S.C. 371(b) or (f) from an international application.
20. 35 U.S.C. § 154(b)(1)(B), entitled "GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY" provides:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after **the actual filing date** of the application in the United States, not including-

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. [Emphasis added.]

21. 37 C.F.R. § 1.702(b), entitled "FAILURE TO ISSUE A PATENT WITHIN THREE YEARS OF THE ACTUAL FILING DATE" provides:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) **or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application**, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);
- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant. [Emphasis added.]

22. 35 U.S.C. §371, titled "NATIONAL STAGE: COMMENCEMENT" provides in pertinent part:

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. [Emphasis added.]

23. Consistent with the use of an "actual filing date" in the United States for determining patent term adjustments, the USPTO measures the three year pendency provision in 35 U.S.C. 154(b)(1)(B) from the date that the national stage commences under 35 U.S.C. 371(b), as well as 35 U.S.C. 371(b)(f) in an international application. See Exhibit B entitled "Notice Concerning Calculation of the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) involving International Applications Entering the National Stage Pursuant to 35 U.S.C. § 371" (signed 09 September 2009)
24. Thus, Applicant submits the patent term adjustment should be credited to instant application based on its actual filing date under 35 U.S.C. 371, either section (b) or (f). For the purposes of the calculation of the corrected patent term adjustment as required by C.F.R. 1.705(b)(2)(i), Applicant will use the 35 U.S.C. 371(f) date of September 24, 2009.

B. Applicant submits that Applicant is entitled to a patent term adjustment of two hundred ninety six days (296) under 37 CFR § 1.702.

25. An inspection of the Patent Term Adjustments page on PAIR, a copy of which is attached hereto as Exhibit A, reveals that the Office accorded, as of June 26, 2009, the mailing date of the second Notice of Allowance, zero (0) days of Patent Term Adjustment attributable to Applicant delay. Applicant submits that under 35 U.S.C. § 154(b)(2)(C) and 37 CFR § 1.704(b) the calculation of Applicant delay is ninety five (95) days. The delay of ninety five (95) days is the sum of Applicant's 3 day delay in responding to the restriction requirement mailed August 28, 2003, and Applicant's 92 day delay in responding to the office action mailed February 19, 2004.

26. An inspection of the Patent Term Adjustments page on PAIR, a copy of which is attached hereto as Exhibit A, reveals that the Office accorded, as of June 26, 2009, the mailing date of the second Notice of Allowance, zero (0) days of Patent Term Adjustment attributable to delays under 35 U.S.C. § 154(b)(1) and 37 CFR § 1.702(a) and (b). Applicant submits that the delay under 35 U.S.C. § 154(b)(1) and 37 CFR § 1.702(a) and (b) is three hundred ninety one (391) days.
27. The three hundred ninety one (391) day delay is the sum of the two hundred sixteen (216) day delay under 35 U.S.C. § 154(b)(1)(A) and 37 CFR § 1.703(a)(1) for failure to issue a first office action within fourteen months of the date of completion date of the requirements of 371, and a one hundred and seventy five (175) day delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(b) for failure to issue a patent within three years ("three year rule").
28. The three year rule under 35 U.S.C. § 154(b)(1)(B) and 37 CFR § 1.703(b) reflects the adjustment to the term of the patent for failure to issue the patent within three years of the actual filing date of the application. Under 35 U.S.C. § 154(b)(1)(B)(i) and 1.703(b)(1), the three year rule does not include any time consumed by continued examination of the application requested by the applicant under section 132(b). Applicant filed an RCE on March 18, 2005, which is three years PLUS one hundred and seventy five (175) days after the 35 U.S.C. 371(f) date of September 24, 2009.
29. The fourteen month rule reflects the adjustment to the term of the patent for failure to issue a first office action within fourteen months of the date of completion date of the requirements of 371, (37 CFR § 1.703(a)(1)). The USPTO issued a first office action on August 28, 2003, which is fourteen months PLUS two hundred and sixteen (216) days after the 35 U.S.C. 371(f) date of September 24, 2009.

30. Applicant submits that according to 35 U.S.C. § 154(b)(2)(A), Applicant is entitled to a patent term adjustment that reflects the delay under 154(b)(1)(B) incurred by not issuing a patent within three years of the actual date of filing of the application plus the delay under 154(b)(1)(A) by the USPTO that occurred within the first three years of the application's pendency.

31. 35 U.S.C. § 154(b)(2)(A) provides in part that:

"[t]o the extent that periods of delay attributable to grounds specified in paragraph (1) [i.e., 35 U.S.C. 154(b)(1)] overlap, the period of any adjustment granted under this subsection shall not exceed the number of actual days the issuance of the patent was delayed".

32. 35 U.S.C. § 154(b)(1) provides in part:

(b) ADJUSTMENT OF PATENT TERM.-

(1) PATENT TERM GUARANTEES.-

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to-

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after- the date on which an application was filed under section 111(a) of this title; or the date on which an international application fulfilled the requirements of section 371 of this title;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including-

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

33. In accordance with 35 U.S.C. § 154(b)(2)(A), Applicant does not consider the 175 day delay under 154(b)(1)(B) which occurred after September 24, 2004, to be overlapping with the 216 day delay under 154(b)(1)(A) which occurred before September 24, 2004.
34. Thus, Applicant submits that Applicant is entitled to a patent term adjustment that reflects the 175 day delay under 154(b)(1)(B) and 37 C.F.R. § 1.703(b) incurred in issuing a patent after the three year date of filing of the application plus the two hundred and sixteen (216) day delay under 154(b)(1)(A) and 37 C.F.R. § 1.703(a)(1) for failing to issue a first office action within 14 months, for a total of a three hundred and ninety one (391) day delay under non overlapping periods of 154(b)(1)(A) and 154(b)(1)(B).
35. The patent term adjustment is calculated under 35 U.S.C. § 154(b)(2)(C) by subtracting Applicant's delay of ninety five (95) days from the sum of the nonoverlapping delays of three hundred and ninety one (391) days under 35 U.S.C. §§ 154(b)(1)(A) and 154(b)(1)(B) .
36. Applicant calculates that the correct total patent term adjustment is 296 days (391 minus 95) for this application according to 37 C.F.R. § 1.703(f).

RELIEF REQUESTED

37. Applicant respectfully requests the correction of the Patent Term Adjustment to two hundred ninety six (296 days), (391 days of Office delay, less 95days of reduction).
38. Applicant respectfully asserts that this Petition is timely under 37 C.F.R. § 1.705(b) because this Petition is filed no later than the payment of the issue fee.
39. Applicants believe that no fees are due in connection with this Petition other than the petition fee under 37 C.F.R. § 1.18(e). However, if additional fees are due, the Director is hereby authorized to charge Deposit Account No. 04-1105, under Order No. 302934/68323.

Dated: September 25, 2009

Respectfully submitted,

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Attachments: Exhibits A & B